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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/621,275  | 07/17/2003  | William Nelson Davis | XP-1128             | 3036             |
| 7590  | 11/29/2005  |                      | EXAMINER            |                  |
| Breiner, Breiner, Pulsinelli<br>115 North Henry Street<br>P.O. Box 19290<br>Alexandria, VA 22320-0290 |             |                      | FABER, DAVID        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2178                |                  |

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/621,275             | DAVIS ET AL.        |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | David Faber            | 2178                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 July 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>17 July 2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. This office action is in response to the application filed on 17 July 2003.

**This action is made Non-Final.**

2. Claims 1-24 are pending. Claims 1, 11, and 18 are independent claims.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 17 July 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

4. The drawings filed on 17 July 2003 are accepted.

### ***Claim Objections***

5. Claims 15 and 16 are objected to because of the following informalities:
6. Claim 15 is vague and unclear due to the grammar structure and missing words.

It was believed the claim was intended to state, "A font manager as claimed in claim 11, wherein the font tracker monitors the use of the demanded font to enforce the use of the demanded fonts is consistent with the received privilege information" and has been treated as such for the remainder of this Office action.

7. Claim 16 is vague and unclear due to missing words. It was believed the claim was intended to state, "16. A font manager as claimed in claim 11, wherein the font

tracker disables the demanded font after an expiry of a time period defined by the privilege information" and has been treated as such for the remainder of this Office action.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Section 2106 of the MPEP states:

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se  
Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Computer programs are often recited as part of a claim. Office personnel should

determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.

Claims 11-17 are directed towards a font manager that appears to be a computer program per se. A computer program not embodied on a tangible computer readable medium is not statutory.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 2, 6-10, 18-20, 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Ying et al (US Patent #6,853,980, filed 9/7/1999).

As per independent Claim 1, Ying et al discloses a method comprising:

- A font consumer requesting a font from a font provider (FIG 29, 54; Column 22, lines 31-42: Discloses a user having the ability to request a font from the font store)
- The font provider accessing subscription information from the font customer; (Column 10, line 64 - Column 11, line 3: Discloses a record of previous purchase and financial information about the customer's account. In addition, Column 30, lines 22-30 discloses the purchase of the font covers the licensing of the font wherein the license includes the length of time the font may be used.)
- The font provider sending the requested font to the font customer depending on the subscription information. (FIG 35-37: Discloses the use of payment wherein once font provider receives payment, then the font provider provides the font customer the font to be downloaded.)
- The font consumer receiving the requested font and providing the requested font to an application. (Claim 6, Column 32-33: Discloses downloading a font to the client whereby used by the client's operating system.)

As per dependent Claim 2, Ying et al discloses a method further comprising:

- the font consumer accessing a web site of the font provider; (FIG 5,50: Browser access the main homepage of font store)
- the font consumer logging onto the web site; and (FIG 32-33; Column 23, lines 17-33)

- the font consumer identifying the requested font. (FIG 29: Fonts identified by the request are added to the user's shopping cart account whereby the customer is able to identify the fonts selected)

As per dependent Claim 6, Ying et al discloses a method comprising:

- the font provider giving privilege information with the font, the privileges information defining approved uses for the requested font by the font consumer. (Column 30, lines 22-30: Discloses the use of a license of limitations of use on copying, distribution among machines, and number of characters used.)

As per dependent Claim 7, Ying et al discloses a method comprising:

- the font provider giving lifetime information with the font, the lifetime information defining a time period for which the font consumer is authorized to use the font. (Column 30, lines 22-30: Discloses a license stating on the length of time for which the downloaded font could be used)

As per dependent Claim 8, Claim 8 recites similar limitations as in Claim 7.

Therefore, Claim 8 is similarly rejected under Ying et al.

As per dependent Claim 9, Ying et al discloses a method comprising:

- installing the font on the font consumer. (Column 11, lines 50-53: font manager installs the font onto the operating system)

- As per dependent Claim 10, Ying et al discloses a method comprising:
- installing the font in random access memory of the font consumer. (It is inherent for a font to be installed into random access memory in order for it to be used by applications such as a word processing program.)

- As per independent Claim 18, Ying et al discloses a method comprising:
- a font consumer requesting a font from a font provider (FIG 29) and providing payment for the font; (FIG 34-35)
  - the font provider sending the requested font to the font consumer (FIG 37 – the store server sends the font once it receives a request for a font download) along with a license for the font consumer that enables the font consumer to use the font for a specified period of time; and (Column 30, lines 22-30 – Discloses the license to include the length of time that could be used)
  - the font consumer receiving the requested font and providing the requested font to an application (Claim 6, Column 32-33: Discloses downloading a font to the client whereby used by the client's operating system.) for the specified period of time. (Column 30, lines 22-30 – Discloses the license to include the length of time that could be used)

As per dependent Claim 19, the applicant recites similar limitations for performing the method of Claim 1. Therefore, Claim 19 is similarly rejected under Ying et al.

As per dependent Claim 20, the applicant recites similar limitations for performing the method of Claim 2. Therefore, Claim 20 is similarly rejected under Ying et al.

As per dependent Claim 22, the applicant recites similar limitations for performing the method of Claim 6. Therefore, Claim 22 is similarly rejected under Ying et al.

As per dependent Claim 23, the applicant recites similar limitations for performing the method of Claim 7. Therefore, Claim 23 is similarly rejected under Ying et al.

As per dependent Claim 24, the applicant recites similar limitations for performing the method of Claim 8. Therefore, Claim 24 is similarly rejected under Ying et al.

11. Claims 11, 15, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayes et al (US Patent #6,882,344, filed 7/25/2000).

As per independent Claim 11, Hayes et al discloses a font manager on a computer comprising:

- a font request interceptor receiving demands for fonts from applications running on the computer; (e.g. Column 1, lines 63-65; Column 7, lines 7-18 – A user selects a font from a word processing system wherein the operating system responds to the action, and returns the details of the font for use in the word processing program. Therefore, the operating system act as a interceptor.)
- a font retriever for requesting the demanded fonts from a remote font provider if the demanded fonts are not installed on the computer; (Column 7, lines 25-36)

- a font installer for receiving and installing the demanded fonts; and (Column 7, line 63 – Column 8, line 5; Column 4 lines 32-33 – The update function receives the font onto the font manager wherein the user can activate the font in which the font manager installs the activated font. )
- a font tracker for controlling use of the demanded fonts by the applications in response to privilege information received from the remote font provider. (Column 3, lines 38-45 – Discloses an embodiment wherein the maximum number of users, e.g. licenses, are able to access the font.)

As per dependent Claim 15, Hayes et al discloses

- wherein the font tracker monitors the use of the demanded font to enforce the use of the demanded fonts is consistent with the received privilege information. (e.g. Column 10, lines 25-34: Discloses an embodiment wherein the maximum number of authorized users of using the font is ten, and if the number of users goes above ten, then the others above ten accessing the font will be denied. Shows consistency that if the license states only ten authorized users are only allowed to access the font, then no more than ten users are able to access the font.)

As per dependent Claim 17, Hayes et al discloses a method comprising:

- installing the font in random access memory of the font consumer. (It is inherent for a font to be installed into random access memory in order for it to be used by applications such as a word processing program.)

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ying et al (US Patent #6,853,980, filed 9/7/1999).

As per dependent Claim 3, Ying et al fails to specifically disclose the font provider is able to accessing a subscriber database; looking up the font consumer in the subscriber database, and reading font privileges associated with the font consumer. However, Ying et al discloses an e-commerce server by the font store that includes a database containing data for each customer that includes an ID, user name, user password, shopping cart for storing fonts not purchased yet, and account history that include record of previously purchased fonts and financial information of the customer's account. (FIG 1; Column 10, line 64 - Column 11, line 3) In addition, Ying et al discloses the use of licenses on the limitations on the purchase of fonts. (Column 30, lines 22-30) It would have been obvious to one of ordinary skill in the art at the time of applicant's

invention to have used Ying et al's method with the font store to have access user privilege and financial information since it would have enabled a system to aid in the distribution, buying, and selling of fonts.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ying et al (US Patent #6,853,980, filed 9/7/1999) in further in view of Nagy et al (US PGPub 2003/0119478, filed 7/22/2002).

As per dependent Claim 4, Ying et al fails to specifically disclose further comprising debiting an account of the consumer. However, Nagy et al discloses the use of a subscriber entering a debit card number into a website and the subscriber's card account is debited. (Paragraph 0004, lines 7-10)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Ying et al's method with Nagy et al's method since Nagy et al's method would have provided a method and system for prepaying that enables the use of debit card payments which can be accepted from virtually any issuing financial institution.

15. Claims 5, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ying et al (US Patent #6,853,980, filed 9/7/1999) in further in view of Barron (US PGPub 2001/0042124, filed 1/26/2001).

As per dependent Claim 5, Ying et al fails to specifically disclose that the font provider encrypting the font prior to transmission to the font consumer. However, Barron

discloses a method of encrypting electronic data into an encrypted data packet on a server prior to being retrieved. (Paragraph 0023, line 7 – Paragraph 0024, line 2).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Ying et al's method with Barron's method since Barron's method would have facilitated virtually impregnable security for the delivery, storage and sharing of documents and files.

As per dependent Claim 21, the applicant recites similar limitations for performing the method of Claim 5. Therefore, Claim 21 is similarly rejected under Ying et al and Barron.

16. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes et al (US Patent #6,882,344, filed 7/25/2000) in further view of Ying et al (US Patent #6,853,980, filed 9/7/1999)

As per dependent Claim 12, Hayes et al discloses the font manager providing information of a licensed font to be activated wherein font manager transmits a request for activation signal. (Column 10, lines 43-45) Nevertheless, Hayes et al fails to specifically disclose that the information included subscription information. However, Ying et al discloses information regarding the license containing of the length of time the font can be used.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Hayes et al's method with Ying et al's method

since Ying et al's method would have provided a system which aids in buying, selling, and distribution of fonts.

As per dependent Claim 13, Hayes et al fails to specifically disclose the font retriever accesses a web site of the font provider and logs onto the web site to be identified by the font provider. However, Ying et al discloses accessing a web site of the font provider; (FIG 5,50: Browser access the main homepage of font store), logging onto the web site to be identified by the font provider. (FIG 32-33; Column 23, lines 17-33)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Hayes et al's method with Ying et al's method since Ying et al's method would have provided a system which aids in buying, selling, and distribution of fonts.

17. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes et al (US Patent #6,882,344, filed 7/25/2000) in further in view of Barron (US PGPub 2001/0042124, filed 1/26/2001).

As per dependent Claim 14, Hayes et al fails to specifically disclose that the font retriever decrypts the demanded font. However, Barron discloses a method of downloading a decryption applet and decrypting the encrypted data packet at the client workstation. (Paragraph 0024, lines 9-13).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Ying et al's method with Barron's method since

Barron's method would have facilitated virtually impregnable security for the delivery, storage and sharing of documents and files.

18. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes et al (US Patent #6,882,344, filed 7/25/2000).

As per dependent Claim 16, Hayes et al fails to specifically disclose the font tracker disables the demanded font after expiry of a time period defined by the privilege information. However Hayes et al discloses a feature of a font for sale could be sampled for a period of time and disabled when the font when the time expired. (Column 8, lines 46-48) It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Hayes et al's method with Hayes et al's feature of disabling the font after time expired in order to provide a font management system for implemented limited access to fonts.

### ***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Manchala et al (US PGPub 20030079134): Discloses special fonts could be leased or borrowed.
- McQueen et al (US Patent #5,586,242): Discloses the use of a font manager.
- Gartland (US Patent #6,512,531): Discloses a font navigation tool.
- Teshima (US PGPub 20030131321): Discloses a method for retrieving fonts.

- Chan et al (US Patent #6,073,147): Discloses a system for distributing fonts over a network
- Simon et al (US Patent #6,065,008): Discloses a system and method for securing distributing font subsets.
- Colletti (US Patent #5,990,907): Discloses an font management within an operating system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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David Faber  
Examiner  
Art Unit 2178

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*Stephen Hong*

**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**